

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HOLOGIC, INC., and CYTYC SURGICAL
PRODUCTS, LLC,

Plaintiffs,

v.

MINERVA SURGICAL, INC.,

Defendant.

C.A. No. 15-1031-JFB-SRF

PLAINTIFFS' RESPONSE TO MINERVA'S NOTICE OF SUBSEQUENT FACTS

Plaintiffs Hologic, Inc. and Cytac Surgical Products, LLC (collectively, "Hologic") respond to Minerva's April 22, 2019 notice of subsequent facts. (D.I. 614.)

Minerva is incorrect when it argues that "Hologic no longer has 'any cause of action based on [the '183 patent] claim, and any pending litigation in which the claims are asserted becomes moot.'" (D.I. 614 at 1.) The Court rejected this very argument when it denied Minerva's Motion to Dismiss: "[A] determination of patentability . . . occur[s] only after *all appeals* have terminated" and the "Patent Office cannot cancel claims of patents until after appeal." (D.I. 407 at 31 (citing 35 U.S.C. § 318(b) and *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 645 (Fed. Cir. 2011).) Here, the appeal is not terminated, so the USPTO has not and cannot cancel any claims of the '183 Patent. The time to file petitions for rehearing, reconsideration and/or certiorari has not expired and substantive decisions on those petitions may not issue until 2020.

More importantly, the cancellation of the patent, even assuming that had occurred, would not help Minerva avoid liability in this case due to assignor estoppel. *See Am. Fence Co. v.*

MRM Sec. Sys., Inc., 710 F. Supp. 37 (D. Conn. 1989); *AgroFresh Inc. v. Mirtech, Inc.*, C.A. No. 16-662-MN-SRF, D.I. 310 at 9 (D. Del. Nov. 28, 2018).

Both the applicability of assignor estoppel and the impact of the pending '183 Appeal on this litigation have already been fully briefed in the context of Minerva's Motion to Dismiss and Hologic's post-trial motions. (*See, e.g.*, D.I. 276 at 3-9; D.I. 291 at 19-20; D.I. 320 at 3-5; D.I. 323 at 3-6; D.I. 340 at 3-5; D.I. 533 at 17-18; D.I. 547 at 19; D.I. 567 at 10; D.I. 599 at 1-2; D.I. 604 at 1-3.) The additional briefing requested by Minerva in the form of "status reports" is unnecessary. Hologic is available for a telephonic status conference at the Court's convenience.

DATED: April 23, 2019

YOUNG CONAWAY STARGATT & TAYLOR LLP

Of Counsel:

/s/ Karen L. Pascale

Matthew M. Wolf
Marc A. Cohn
ARNOLD & PORTER LLP
601 Massachusetts Ave., NW
Washington, DC 20001-3743
Telephone: (202) 942-5000
matthew.wolf@arnoldporter.com
marc.cohn@arnoldporter.com

Karen L. Pascale (#2903)
Pilar G. Kraman (#5199)
Rodney Square
1000 North King Street
Wilmington, DE 19801
Telephone: (302) 571-6600
kpascale@ycst.com
pkraman@ycst.com

Jennifer A. Sklenar
ARNOLD & PORTER LLP
777 South Figueroa Street, 44th Floor
Los Angeles, CA 90017-5844
Telephone: (202) 243-4000
jennifer.sklenar@arnoldporter.com

*Attorneys for Plaintiffs Hologic, Inc.
and Cytoc Surgical Products, LLC*

Ryan J. Casamiquela
ARNOLD & PORTER LLP
Three Embarcadero Center
San Francisco, CA 94111-4024
Telephone: (415) 471-3100
ryan.casamiquela@arnoldporter.com

David A. Caine
Philip W. Marsh
Assad H. Rajani
ARNOLD & PORTER LLP
Five Palo Alto Square
3000 El Camino Real, Suite 500
Palo Alto, CA 94306
Telephone: (650) 319-4500
david.caine@arnoldporter.com
philip.marsh@arnoldporter.com
assad.rajani@arnoldporter.com

CERTIFICATE OF SERVICE

I, Karen L. Pascale, Esquire, hereby certify that on April 23, 2019, I caused to be electronically filed a true and correct copy of the foregoing document with the Clerk of the Court using CM/ECF (which will send notification that such filing is available for viewing and downloading to all registered counsel), and in addition caused true and correct copies of the foregoing document to be served upon the following counsel of record by electronic mail:

Attorneys for Defendant Minerva Surgical, Inc.:

Benjamin J. Schladweiler
GRRENBURG TRAURIG LLP
The Nemours Building
1007 North Orange Street
Suite 1200
Wilmington, DE 19801

schladweilerb@gtlaw.com

Vera M. Elson
Dale R. Bish
Christopher D. Mays
WILSON SONSINI GOODRICH & ROSATI
650 Page Mill Road
Palo Alto, CA 94304-1050

velson@wsgr.com
dbish@wsgr.com
cmays@wsgr.com

Edward G. Poplawski
Olivia M. Kim
Erik J. Carlson
Neil N. Desai
WILSON SONSINI GOODRICH & ROSATI
633 West Fifth Street, Suite 1550
Los Angeles, CA 90071

epoplawski@wsgr.com
okim@wsgr.com
ecarlson@wsgr.com
ndesai@wsgr.com

YOUNG CONAWAY STARGATT & TAYLOR, LLP

/s/ Karen L. Pascale

April 23, 2019

Karen L. Pascale (No. 2903) [kpascale@ycst.com]
Pilar G. Kraman (#5199) [pkraman@ycst.com]
Rodney Square
1000 North King Street
Wilmington, Delaware 19801
Telephone: 302-571-6600

*Attorneys for Plaintiffs, Hologic, Inc.
and Cytoc Surgical Products, LLC*